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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

COLON, CATHERINE M

ART UNIT PAPER NUMBER

3623

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/746,611

Applicant(s)

PERRY ET AL.

Examiner

C. Michelle Colon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,7,8,12-18,22-26 and 28-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,7,8,12-18,22-26 and 28-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 3, 2005 has been entered.

Claims 1, 4, 14, 18 and 32 have been amended. Claims 2, 5, 6, 9-11, 19-21 and 27 have been cancelled. Claims 39-48 have been added. Claims 1, 3, 4, 7, 8, 12-18, 22-26 and 28-48 are now pending in this application.

Response to Amendment

2. Applicant's amendments to claims 1, 4, 14, 18 and 32 are acknowledged.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3, 4, 7, 12-18, 22-26, 28-36 and 38-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over the article, "Public Private Partnership," May 1999 and the proposal evaluation tool, FedSelect, September 1999.

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As per claim 1, "Public Private Partnership" discloses a method of evaluating a business proposal, comprising the steps of:

gathering information relevant to the proposal, wherein the information comprises revenue elements of the proposal, risks, descriptive information, business issues, business goals, a value of the proposal, a cost of the proposal, methods of achievement of the proposal, and an innovation value of the proposal, and wherein the proposal includes at least two alternative structures between a purchaser and a provider selected from the group consisting of an alliance, an acquisition, an equity venture, a partnership, and a venture (last paragraph of page 6; Figure 2.1 beginning on page 7, Types of Public Private Partnerships; pages 67-68; pages 70-72; The article discloses the different ways to structure partnership deals/proposals, which include different levels of risk, rewards and responsibilities to the parties involved. The article also discusses the contents that should be in a proposal including cost, business issues, methods of achievement, etc.);

evaluating the gathered information (pages 74 and 75; The article discloses evaluating the information relevant to the proposals using various evaluation criteria.); and

ranking the at least two structures according to the evaluation of the gathered information (pages 76 and 77; The article discloses proposal evaluators ranking each evaluation criterion for each proposal and then adding the scores to determine the best-suited proposal.).

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"Public Private Partnership" does not expressly disclose evaluating the information by computer. FedSelect discloses a software tool that allows users to evaluate proposals using a computer (page 3). It was known at the time of the invention that merely providing an automated way to replace a well-known activity which accomplishes the same result is not sufficient to distinguish over the prior art. *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). Thus, at the time of the invention it would have been obvious to a person of ordinary skill in the art for the proposal evaluation process of "Public Private Partnership" to utilize a computer as taught in the proposal evaluation software tool of FedSelect because automating many of the manual evaluation steps would streamline the proposal evaluation process, thus making it more efficient (page 4 of FedSelect disclose a benefit of the tool as streamlining the proposal evaluation process).

As per claim 3, "Public Private Partnership" does not expressly disclose the method of claim 1, further including the use of templates to gather information. FedSelect discloses the method of claim 1, wherein the information gathering step further comprises answering predetermined questions on at least one template stored in a computer and the answers to at least one predetermined question call up at least one more template of predetermined questions, and the computer uses answers to said questions to evaluate the proposal (page 3; The software tool guides evaluators through a set of online forms in which they answer questions relating to the proposals such as ratings, rationale, comments, etc.). As discussed above, it was known at the time of the invention that merely providing an automated way to replace a well-known activity which

accomplishes the same result is not sufficient to distinguish over the prior art. *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). Thus, at the time of the invention it would have been obvious to a person of ordinary skill in the art for the proposal evaluation process of "Public Private Partnership" to gather information utilizing templates on a computer as taught in the proposal evaluation software tool of FedSelect because the templates help to automate the information gathering process and automating many of the manual evaluation steps would streamline the proposal evaluation process, thus making it more efficient (page 4 of FedSelect disclose a benefit of the tool as streamlining the proposal evaluation process).

As per claim 4, "Public Private Partnership" discloses the method of claim 1, wherein the proposals are evaluated by calculating at least one of a revenue stream, a return on average assets, a return on investment, a return on equity, an internal rate of return, and a net present value (pages 44 and 71; The article discloses considerations of revenue, cost, ROI, etc. when evaluating the proposals.).

As per claims 7, 12, 13 and 15-17, "Public Private Partnership" does not expressly disclose the method of claim 1, further comprising displaying the rankings with a graphical user interface; or wherein the information is input to the computer through a graphical user interface by choosing selections from at least one of a drop-down screen, a scroll screen, a check box, and a list box; or wherein the information is provided through a graphical user interface, and the input is in a form of brief numerical or pseudo-numerical outputs. FedSelect discloses displaying the rankings and having evaluators submit information via a graphical user interface (page 3). At the time of the

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invention, it would have been obvious to a person of ordinary skill in the art to combine the teachings of "Public Private Partnership" and FedSelect based on the rational and motivation supplied in the claims above.

As per claim 14, "Public Private Partnership" discloses the method of claim 1, wherein the proposal comprises an offer of a service from the provider, and further comprising the step of calculating a way to pay for the proposal (page 2; Figure 2.1 beginning on page 7; page 71; The article discloses establishing partnerships to deliver some type of service.).

Claims 18, 22-26, 28-36 and 38 recite substantially similar subject matter as claims 1, 3, 4, 7 and 12-17 above. Therefore, claims 18, 22-26, 28-36 and 38 are rejected on the same basis as claims 1, 3, 4, 7 and 12-17.

As per claim 39, "Public Private Partnership" discloses the method of Claim 1, wherein the alternative structures between the purchaser and the provider differ in an amount of equity owned by the purchaser and the provider (pages 42, 71, 98; Figure 2.1 beginning on page 7; The article discloses that different amounts of equity may be owned by the parties involved in the partnership structure based on the type of structure established.).

As per claim 40, "Public Private Partnership" discloses the method of Claim 1, wherein an advantage of at least one of the structures is creation of an asset (pages 68,

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94 and 97; The article discloses the transfer of assets that may arise from a particular deal structure.).

As per claim 41, "Public Private Partnership" discloses the method of Claim 1, wherein the provider furnishes information to the purchaser demonstrating a difference in value to the purchaser based on the alternative structures (pages 45, 54, 71 and 72; The article discloses how all parties in the potential partnership assess the various partnership structure types for their value.).

As per claim 42, "Public Private Partnership" discloses the method of Claim 1 wherein at least one of cost drivers and revenue drivers is used to evaluate and rank the structures (pages 71 and 80; The article discloses considerations of revenue, cost, ROI, etc. when evaluating the proposals.).

As per claim 43, "Public Private Partnership" discloses the method of Claim 1, wherein the values of the at least two alternative structures are calculated as revenue streams to the purchaser (pages 44 and 71; The article discloses a party considering the revenue generating potential of establishing the partnership.).

As per claim 44, "Public Private Partnership" discloses the method of Claim 1, wherein the values of the at least two structures are calculated as at least one of a revenue stream, a return on average assets, a return on investment, a return on equity, an internal rate of return, and a net present value (pages 44 and 71; Figure 2.1 beginning on page 7; The article discloses assessing revenue stream, ROI, etc. for the different types of partnership structures.).

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As per claim 45, "Public Private Partnership" discloses the method of Claim 18, wherein the provider is a service provider and the advantages of the structures are calculated as a revenue stream to the purchaser (pages 44 and 71; The article discloses a party considering the revenue generating potential of establishing the partnership.).

As per claim 46, "Public Private Partnership" discloses the method of Claim 18, wherein the alternative structures differ in an amount of equity owned by the purchaser and the provider (pages 42, 71 and 98; Figure 2.1 beginning on page 7; The article discloses that different amounts of equity may be owned by the parties involved in the partnership structure based on the type of structure established.).

As per claim 47, "Public Private Partnership" discloses the method of Claim 18, wherein an advantage of at least one of the structures is creation of an asset (pages 68, 94 and 97; The article discloses the transfer of assets that may arise from a particular deal structure.).

As per claim 48, "Public Private Partnership" discloses the method of Claim 18, wherein at least one of cost drivers and revenue drivers is used to calculate advantages for the structures (pages 71 and 80; The article discloses considerations of revenue, cost, ROI, etc. when evaluating the proposals.).

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5. Claims 8 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over the article, "Public Private Partnership," May 1999 and the proposal evaluation tool, FedSelect, September 1999 as applied above.

As per claim 8, "Public Private Partnership" and FedSelect do not expressly disclose the method of claim 7, wherein the rankings are presented in a Harvey-ball format. However, FedSelect discloses displaying rankings via a graphical user interface (page 3). The Harvey-ball format is an old and well known display format that uses moon phases to indicate association levels of an item based on certain criteria. The Harvey-ball format provides a quick and easy way for a user to view compare items based on certain criteria. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to display rankings of items using a Harvey-ball format because such a display would provide users with a quick and easy means for assessing the rankings.

Claim 37 recites substantially similar subject matter as claim 8 above. Therefore, claim 37 is rejected on the same basis as claim 8 above.

Response to Arguments

6. Applicant's arguments are moot in view of the new grounds of rejections.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Pivnicny, Vincent et al. "Criteria Help Hospitals Evaluate Vendor Proposals," *Healthcare Financial Management*, Jun 1989 [retrieved from Internet], discusses a proposal evaluation process using weights and ranking of criteria;
- Green, Janet. "The anatomy of an acquisition," *Management Review*, May 1993 [retrieved from Proquest], discusses key criteria to be considered in a proposal for an acquisition;
- Triantis, John. "Forecasting for acquisition and joint venture projects," *The Journal of Business Forecasting Methods & Systems*, Fall 1996 [retrieved from Proquest], discusses what considerations to make in mergers and acquisitions;
- Tailin Chi. "Option to acquire or divest a joint venture," *Strategic Management Journal*, June 2000 [retrieved from Proquest], discusses assessing options in joint ventures;
- Kalinka, Susan. "Proposed regulations concerning partnership mergers and divisions provide guidance and some, but not enough, flexibility," *Taxes*, Aug 2000 [retrieved from Proquest], discusses structuring regulations for partnership mergers and acquisitions;
- "State of Connecticut Request for Proposal – Proposal Requirements and Process," 2000 [retrieved from Internet], discusses a detailed outline of a proposal requirements and process;

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- Gransberg, Douglas. "Evaluating best value contract proposals," *Transactions of AACE International*, 1997, [retrieved from Dialog], discusses the government's approach to evaluating contract proposals; and
- "PAI Selected by US WEST as Participant in Initiative to Streamline Procurement," *Business Wire*, October 4, 1999 [retrieved from Dialog], discusses PAI's commercial off the shelf products, including the proposal evaluation software, FedSelect.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Michelle Tarae (formerly, C. Michelle Colon) whose telephone number is 571-272-6727. The examiner can normally be reached Monday – Friday from 8:30am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached at 571-272-6729.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

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or faxed to:

703-872-9306 [Official Communications; including After Final
communications labeled "Box AF"]

571-273-6727 [For status inquiries, draft communication, labeled
"Proposed" or "Draft"]

Hand delivered responses should be brought to:

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cmc

April 25, 2005


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